

## **REMARKS**

### ***Status of the Claims***

The present Office Action addresses claims 1-16. Claims 17-23 were previously cancelled, claims 4, 6, 11, and 15 were previously withdrawn. Applicant respectfully requests reconsideration of pending but rejected claims 1-3, 5, 7-10, 12-14, and 16 in view of the remarks herein.

### ***Amendments to the Claims***

Claim 1 is amended to include the limitations of claim 7, which is now cancelled. Claim 12 is amended to include the limitations of claim 13, which is now cancelled. Claim 14 is amended to depend from claim 12 instead of now-cancelled claim 13.

### ***Rejections Pursuant to 35 U.S.C. §102***

Claims 1-3, 5, 12, and 16 are rejected pursuant to 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0147936 ("Rosenberg"). Applicant respectfully disagrees.

As noted above, claim 1 is amended to include the limitations of claim 7, thereby obviating the basis for this rejection. Accordingly, independent claim 1, as well as claims 2-3 and 5 which depend therefrom, distinguish over Rosenberg and represent allowable subject matter.

Independent claim 12 as amended recites an actuator threadably coupled to one of first and second components and effective to move at least one of the components with respect to the other component. Rosenberg does not teach or even suggest that the actuator is *threadably* coupled to one of the first and second components. Rosenberg's actuator is merely a trigger that advances the pusher distally. The trigger is not threadably coupled to anything. Accordingly, independent claim 12, as well as claim 16 which depends therefrom, distinguish over Rosenberg and represent allowable subject matter.

### ***Rejections Pursuant to 35 U.S.C. § 103***

Claims 8-10 and 14 are rejected pursuant to 35 U.S.C. § 103(a) as being obvious over Rosenberg in view of U.S. Patent No. 5,020,519 ("Hayes").

Applicants submit that Rosenberg, which is prior art under §102(e) and which is commonly assigned with the present application, may not be used to reject the claims of this application.

Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. §102(e) . . . may be used as prior art under 35 U.S.C. §103 against a claimed inventor unless the entire rights to the subject matter and the claimed invention were . . . subject to an assignment to the same . . . organization at the time the claimed invention was made.


37 C.F.R. §1.104(c)(4). See also 35 U.S.C. §103(c). Both U.S. Publ. No. 2004/0147936 to Rosenberg and the present application are assigned to DePuy Acromed, Inc. of Cleveland, Ohio, which is now DePuy Spine, Inc. by virtue of a subsequent change of name as demonstrated in the Certificate of Amendment which is attached hereto. The assignment for the present application is recorded with the United States Patent and Trademark Office at Reel 9180, Frame 0515, and the assignment of Rosenberg is recorded with the United States Patent and Trademark Office at Reel 014091, Frame 0378 . Rosenberg therefore cannot be used as prior art under §103. Claims 8-10 and 14 are therefore allowable claims.

### ***Conclusion***

Applicant submits that all claims are in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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